Remarks / Arguments

As a result of this amendment, claims 2-4 and 8 are pending in the application. Claims 5-7 have been cancelled.

The present official action is not in appropriate form. In this official action, the examiner has maintained his rejection of claims 2-8. However, he has not given reasons for rejecting any particular claims, thereby forcing the applicants to make a number of assumptions regarding his reasoning. This is unfortunate.

Although the examiner states that the applicants have filed a terminal disclaimer to obviate the nonstatutory double patenting rejection of claims 2-8 made in the previous official action, he fails to acknowledge that this double patenting rejection in fact has been overcome by the terminal disclaimer. Applicants assume that the double patenting rejection has been overcome by the terminal disclaimer, but request that the examiner confirm this or state why the rejection is still pending.

In the previous official action, the examiner had rejected claims 5 and 7 on grounds of nonenablement. He did not reject claims 2-4 or 8 on any ground except for obviousness-type double patenting. In the applicants previous response, applicants argued that claims 5 and 7 were enabled, and submitted an appropriate terminal disclaimer to obviate the double patenting rejection of claims 2-8.

The previous official action stated that "A timely filed terminal disclaimer in compliance with 37 CFR 1.321 may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application." The examiner has both case files and is aware that both applications are commonly owned. Accordingly, the terminal disclaimer should have overcome the double patenting rejection with respect to claims 2-8.

The text of the present official action apparently deals with method claims 5-7 without specifying these method claims by number. In the present official action, the examiner makes a

number of misstatements, in particular, "metalloproteases refer to retro-viruses, not cancer", "alleviation of osteoarthritis means the claims could possibly mean 'preventing osteoarthritis'. As method claims 5-7 have now been cancelled, any residual nonenablement rejection with respect to them should be overcome.

The official action does not give reasons for the rejection of claims 2-4 or 8, and the applicants do not know how to respond.

The examiner also states the "Applicants use of the term aromatic and heteroaromatic goes beyond the purview of the species listed in claim 1, now claim 8." The applicants respond that they did not use the above-mentioned terms even in claim 1, and these terms are not used in claim 8, so applicants do not understand the examiner's problem.

Claim 8 is now the head claim and recites certain chemical compounds, specifically, the two enantiomeric forms of a single compound, and the racemic mixture of these. The examiner has not indicated why this claim is still not considered patentable.

Claim 2 is drawn to a composition of a compound of claim 8 and a carrier, and the examiner has not indicated why this claim is still not considered patentable.

Claim 3 is drawn to a method of inhibiting matrix metalloprotease activity in a mammal, and the examiner has not indicated why this claim is still not considered patentable.

Claim 4 is a dependent claim referring to claim 3, and the examiner has given no reason why this claim should not be patentable.

In summary, claims 5-7 are cancelled, thereby obviating the previous eneblemant rejection. The previously-submitted terminal disclaimer should have obviated the previous obviousness-type double patenting rejection. Remaining claims 2-4 and 8 should be patentable. If the examiner has any reasons why these claims are not considered patentable, he is urged to communicate them so that the applicants can respond.

In view of the above cancellation of claims 5-7 and the above arguments, this application is deemed to be in condition for allowance, and allowance is accordingly requested.

Respectfully submitted,

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